



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,148	07/24/2006	Yves Demars	278386US6PCT	7796
22850	7590	08/20/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ORLANDO, MICHAEL N				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/550,148

Applicant(s)

DEMARS ET AL.

Examiner

MICHAEL N. ORLANDO

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) 39-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-38 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 09/21/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 26-38 and 50 in the reply filed on May 9th, 2008 is acknowledged.
2. Claims 39-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected machine, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 9th, 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 26-32, 36-38 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiuchikawa et al. (EP 0547327A1).

Regarding claim 26, Kamiuchikawa discloses a method of applying a film to at least one side of a flat substrate via an apparatus (abstract, figure 1). The individual substrates are advanced to the film application unit and they are advanced along their plane (figure 1, reference 6 is the substrate). The film application unit, defined by the entire apparatus, consists of a reel for winding the film which has an axis perpendicular to the substrate feeding direction (figure 1, reference 2). The examiner notes that there is an intricate fitting of the invention of Kamiuchikawa which has numerous parts and sections which run parallel to the feeding substrate with two specific examples being the conveying section (reference 20) and the roller support members (reference 74). The unit of Kamiuchikawa further utilizes a leader of film being applied in strips to the passing substrate by the pressure rollers (reference 28) in contact with the substrate as it traverses, which unwinds the film from the reel (reference 2) as it is pulled down to the substrate. The blade (reference 62B) allows for cutting of the film to the appropriate length for application to the substrate and it can be seen that once the film for

application is cut the trailing edge of the film (reference 1B) from the reel is still present and ready for application to either the next or same substrate as desired.

Kamiuchikawa does not explicitly state the width of the film is chosen as a function of the regions of the substrate to be covered by each film.

It would have been readily apparent (and therefore obvious) to an ordinary skilled artisan at the time of the invention that the thickness of the films being applied through the invention of Kamiuchikawa are defined by the thickness of the films on the reel and therefore the applied film thickness could have been readily modified to tailor the film application thickness with a predictable level of success merely by changing the thickness of the film on the reel.

Regarding claim 27, the claimed method is merely a utilization of the apparatus of Kamiuchikawa. The method is primarily drawn to controlling the placement and advancement of the film bands relative to the substrate. Kamiuchikawa provides a feeding reel of film (reference 2), film holders (reference 60), cutters (reference 62B) and pressure rollers for applying the leading edge of the film (reference 28). It would have been obvious to an ordinary skilled artisan seeking to tailor the placement of the film bands to merely manipulate the holding times and cutting locations Kamiuchikawa because as seen in figure 1, the cutting locations and feeding speeds would determine the length and placement of the strips.

Regarding claim 28, Kamiuchikawa discloses the generalized method except for duplicating the film feeding reels on either side of the substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

have duplicated the number of rolls on either side of the substrate, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. As to configuring the rolls so as the film can be overlapped such is merely a location of parts and it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. The solution to applicants particular problem, including more than one roll and configuring them to overlap, would have been readily apparent to an ordinary skilled artisan presented with Kamiuchikawa because clearly the width of the rolls define the width and placement of strips and in so desiring a second overlapping film one would have most reasonably included a second roll which overlapped in width to the first in order to produce an overlapped film application with predictable success.

Regarding claims 29 and 30, the direction of the feeding is merely a function of the orientation of the apparatus. With the apparatus positioned horizontally the film feeds in a horizontal direction and with the apparatus positioned vertically, the film feeds vertically. There is nothing requiring the apparatus of Kamiuchikawa to be in either orientation and such is conceivably useable both ways. It would have been appreciated that the apparatus of Kamiuchikawa could merely be rotated 90 degrees to achieve a different feeding orientation.

Regarding claim 31, the method of Kamiuchikawa utilizes a tentative (i.e. partial) bonding, which is later pressured with rollers to completely apply (i.e. fully bond) (claim 2).

Regarding claim 32, Kamiuchikawa applied a light transmissible resin film (column 8, lines 35-40), which had been previously defined as being a protective film (column 1, lines 30-34).

Regarding claims 36-38, Kamiuchikawa discloses the claimed invention except for a computer optimizing means for applying the films strips. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilized up to date computer technology for optimizing the strip placement, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. As set forth above, the placement of strips is clearly optimizable and tailorable for any desired film applying application and merely incorporating a computerized means for accomplishing such a task would have been within the purview of an ordinary skilled artisan since there is a desire in all arts to make things computerized for reasons that include but are not limited to increasing speed and decreasing human error.

Regarding claim 50, the merits of the process have been addressed above. The sheet produced by the process is merely the inherently resultant product of feeding substrate though the apparatus of Kamiuchikawa.

7. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiuchikawa et al. (EP 0547327A1), as applied to claim 26 above, and further in view of Tuor et al. (GB 2033947).

8. Regarding claims 33-35, Kamiuchikawa discloses a film applying apparatus for applying films to substrates as set forth above; however Kamiuchikawa does not explicitly teach the substrate as an automobile window that is curved.

Tuor, drawn to window covering films for automobiles, discloses a peelable functional film applied to an automobile windshield (figure 1). Automobile windshields are typically (if not always) defined by a radius of curvature, so therefore such would have been clearly obvious if not inherent given the nature of the windshields typically used in the manufacture of automobiles. It can be seen that the driver window is flat and does not possess the same radius of curvature that is typically found in windshields (figure 1).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the method of Tuor with the apparatus of Kamiuchikawa because the combination of familiar elements (i.e. a film applying method being performed with a known film applying apparatus) is taken to be obvious when the combination does no more than produces predictable results. It would have been obvious for an ordinary skilled artisan seeking to apply a film to a glass substrate, as in Tuor, to seek and utilize known techniques and apparatuses (such as that provided by Kamiuchikawa) for accomplishing such a task in quick and efficient manner. As to the location of strips, as set forth above, such would have been readily obvious to an ordinary skilled artisan presented with the apparatus of Kamiuchikawa. Also, as to the limitation of adding numerous strips and then cutting the individual windows from the larger sheet it is noted that as set forth above tailoring the strip placement is easily

achievable with invention of Kamiuchikawa. Also, while neither of Tuor or Kamiuchikawa explicitly teach generating a larger product and then cutting into individually smaller products official notice is taken that it is commonly known across the art that when manufacturing sheet-like products they can either produced individually or cut from a larger sheet and therefore it would have been obvious to an ordinary skilled artisan to select such a common practice as cutting from a larger sheet.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boire et al. (US 6,354,109 B1) also discloses that it was known to provide functional films on glass substrates when producing automobile windows.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL N. ORLANDO whose telephone number is (571)270-5038. The examiner can normally be reached on Monday-Thursday, 7:30am-4:30pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1791

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MO

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791